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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,675	07/02/2003	John C. Marshall	6247.310 CIP	5349

7590 06/30/2004

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EXAMINER	
MCCOY, KIMYA N	

ART UNIT	PAPER NUMBER
3745	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/611,675	MARSHALL, JOHN C.	
	Examiner	Art Unit	
	Kimya N McCoy	3745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-53,55 and 57* is/are rejected.

7)☒ Claim(s) *54 and 56* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 July 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

This application, filed under former 37 CFR 1.60, lacks formal drawings. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings. In unusual circumstances, the formal drawings from the abandoned parent application may be transferred by the grant of a petition under 37 CFR 1.182.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-49, 50, 51, and 52 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-49, 52, 50 and 51 of prior U.S. Patent No. 6,709,238. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 53, 55, and 57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 45, 45 and 40 of U.S. Patent No. 6,709,238. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 45 of the patent "anticipates" application claim 53. Accordingly, application claim 53 is not patentably distinct from patent claim 45. Here, patent claim 45 requires a ceiling fan with a two-piece safety mechanism comprising; a mounting bracket, a ceiling support, a downrod, a hanger ball secured to a mounting bracket, a first cable having a fastener and a connector, and a second cable having a fastener and a connector; said first and second cables being releaseably attached forming one continuous cable while application claim 53 only requires a hanger ball, a major portion, a ceiling fan, a mounting bracket, a first cable having a fastener and a connector and a second cable having a fastener and a connector; said first and second cables being releaseably attached forming one continuous cable. Thus it is apparent that the more specific patent claim 45 encompasses application claim 53. Following the rationale in In re Goodman cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then

obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim 53 is anticipated by Patent claim 45 and since anticipation is the epitome of obviousness, then Application claim 53 is obvious over Patent claim 45.

Claim 45 of the patent "anticipates" application claim 55. Accordingly, application claim 55 is not patentably distinct from patent claim 45. Here, patent claim 45 requires a ceiling fan with a two-piece safety mechanism comprising; a mounting bracket, a ceiling support, a downrod, a hanger ball secured to a mounting bracket, a first cable having a fastener and a connector, and a second cable having a fastener and a connector; said first and second cables being releaseably attached forming one continuous cable while application claim 55 only requires a hanger ball, a major portion, a ceiling fan, a mounting bracket, a first cable having a fastener and a connector and a second cable having a fastener and a connector; said first and second cables being releaseably attached forming one continuous cable. Thus it is apparent that the more specific patent claim 45 encompasses application claim 55. Following the rationale in In re Goodman cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim 55 is anticipated by Patent claim 45 and since anticipation is the epitome of obviousness, then Application claim 55 is obvious over Patent claim 45.

Claim 40 of the patent "anticipates" application claim 57. Accordingly, application claim 57 is not patentably distinct from patent claim 40. Here, patent claim 40 requires an electrical box, a fastening mechanism, an opening, a ceiling fan with a two-piece safety mechanism comprising; a mounting bracket, a ceiling support, a motor, a otor housing, fan blades, electrical wires, a downrod, a hanger ball secured to a mounting bracket, a first cable having a fastener and a connector, and a second cable having a fastener and a connector; said first and second cables being releaseably attached forming one continuous cable while application claim 57 only requires an electrical box, electrical wires, a first cable having a fastener and a connector and a second cable having a fastener and a connector; said first and second cables being releaseably attached forming one continuous cable. Thus it is apparent that the more specific patent claim 40 encompasses application claim 57. Following the rationale in In re Goodman cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim 57 is anticipated by Patent claim 40 and since anticipation is the epitome of obviousness, then Application claim 57 is obvious over Patent claim 40.

Claims 54 and 56 are objected to as being dependent upon a rejected base claim.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimya N McCoy whose telephone number is (703) 305-0863. The examiner can normally be reached on Monday-Thursday 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward K Look can be reached on (703) 308-1044. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimya N McCoy
Patent Examiner
Art Unit 3745

KNM
June 17, 2004

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6/26/04